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In re Application of ALLEN ET AL.
Appl. No.: 10/751,620
Filed: January 06, 2004
For: Control Device for a Railroad Car

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: **DECISION ON PETITION**
: **FOR SUPERVISORY**
: **REVIEW**
: 37 CFR 1.181
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This is a decision on the petition filed July 23, 2005 for supervisory review of an examiner's action under 37 CFR 1.181. Petitioner requests the relief of withdrawal of the Final Office action mailed June 24, 2005, as well as issuance of a new Office action correcting the deficiencies of the Final Office action detailed in the petition.

The petition is **Granted**.

Petitioner discusses multiple alleged deficiencies with the Office action of June 24, 2005. In particular, petitioner alleges that:

1. The rejection of claim 1 is deficient because the structure relied upon in the reference is not detailed by the examiner in the Office action.
2. The rejection of claim 1 is deficient because the examiner has not pointed out in the references where the motivation to combine is located.
3. The rejection of various dependent claims is deficient because elements of the dependent claims 2-4 and 18 are not detailed in the Office action.
4. The finality of the Office action is improper because applicant's arguments on pages 28-37 of the amendment are not specifically rebutted.
5. The Office action is incomplete due to grammatical errors that appear to be missing sentences.


It is also noted that petitioner refers to two telephone interviews with the examiner, where the examiner allegedly admitted that the features of dependent claims 2-4 and 18 were not shown.

With regard to items 1 and 2 above, it appears that the Office action does satisfy the minimum requirements for a properly constructed rejection, and therefore petitioner is not entitled to the requested relief based on these grounds. The examiner has clearly set forth in the rejection and arguments how the claim is being interpreted, how the reference meets the claim based on this interpretation, and how the references are being combined. While petitioner takes exception with the examiner's interpretation and explains such in the arguments, the correctness of a rejection is subject matter for appeal and not petition. Similarly, the examiner is not required to point out explicit motivation in the references by page and line number, but need only supply a motivating factor for the combination based on the evidentiary record and state of the art as a whole. The fact that petitioner provides lucid and well reasoned arguments rebutting the examiner's interpretation and combination clearly shows that the petitioner understands how the examiner is applying the art but simply does not agree with its application. Upon successful appeal, petitioner is entitled to the relief of a reversal of the rejection, but is not entitled to a new Office action or withdrawal of finality.

With regard to items 3, 4 and 5 above, it appears that the Final Office action is deficient with respect to these items. While the examiner is not required to write a detailed novel-sized explanation where features in the references can clearly be discerned by looking at the figures and/or reading the references, further explanation of the features of dependent claims 2-4 and 18, appears appropriate in this instance. This is particularly true in light of the fact that the examiner's response to petitioner's arguments seems to be concentrated on the issues related to claim 1. With respect to the grammatical errors, it is clear that the Office action is missing text, and is therefore incomplete. For the reasons set forth in this paragraph, the petition is granted.

The Finality of the Office action of June 24, 2005 is hereby withdrawn. The application will be forwarded to the examiner for prompt issuance of a new, complete Office action that particularly addresses the deficiencies described above. In addition, petitioner has referenced two interviews with the examiner where the merits of the application have been discussed, yet there is no interview summary record in the application file. The examiner will be directed to include an interview summary properly recording the substance of these interviews with the new Office action.

Telephone inquiries regarding this decision should be directed to S. Joseph Morano, Supervisory Patent Examiner for Art Unit 3617, at (571) 272-6684. Telephone inquiries regarding the status of the claims and other examination related issues should be directed to the examiner of record, Robert McCarry, at (571) 272-6683.


Robert J. Oberleitner
Director, Technology Center 3600

SJM: 9/1/05

